



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper Number 46

In re application of

Randell L. Mills.

Serial No. 09/009,294

Filed: January 20, 1998

For: HYDRIDE COMPOUNDS

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DECISION ON
PETITION
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This is a decision on the SECOND REQUEST FOR RECONSIDERATION OF DECISION ON PETITION FILED June 11, 2002.

A first request for reconsideration was filed November 19, 2001. This request was denied in a decision mailed May 15, 2002.

The grounds for denial set forth in the previous decision of May 15, 2002 are hereby incorporated in this decision. Additionally, the following is in response to the points raised in the instant request for reconsideration.

Petitioner argues that the office failed to consider evidence of record until the final office action. This however is not the case. The evidence of record, including the instant specification was first considered when making the initial 35 USC 112, first paragraph rejections and 35 USC 101 rejections. Applicant responded to this office action with a 65 page response containing numerous new arguments. The examiner, when making the final rejection responded to these arguments for the first time because said arguments had not been previously present in the application.


Despite petitioner's position, the first office action did in fact clearly point out the examiner's position for holding the claims unpatentable and addressed the scientific reasoning set forth as the basis for the rejections.

Petitioner also argues that whether the grounds of rejection in the final office action were still based on lack of utility and enablement is irrelevant as to whether the finality was proper. Petitioner also cites the MPEP, section 706.07(a) and argues that a new ground of rejection does not require raising a new rejection under a different statutory basis. An example is given by petitioner where a rejection under 35 USC 103 is applied and then in a second action a different reference is applied under the same statute. This example is not relevant to the instant fact situation. In this case, not only is the statutory basis the same, but the actual rejection is the same. In petitioner's example, a totally new rejection is applied to the claims.

DECISION

Accordingly, for the reasons set forth in the initial decision mailed November 23, 2001, the reasons set forth in the decision mailed May 15, 2002 and the reasons above, the request for reconsideration is **DENIED**.

It is also noted that this request has been filed as a "Request for reconsideration". Therefore, this matter has been decided in the Technology Center. If Petitioner wishes to invoke the Commissioner's supervisory authority and obtain higher level review of this final decision under 37 CFR 1.181(a)(3), then a petition clearly captioned to that effect must be presented within two months of this decision. The petition should clearly state that "Review" of this decision is requested.



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